APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,969	01/05/2001	Evan S. Huang	2276-02	3976

26797   7590   05/10/2002

SILICON VALLEY PATENT AGENCY, INC.
7394 WILDFLOWER WAY
CUPERTINO, CA 95014

EXAMINER
BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 05/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _30 March 2002_ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-42_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-7,9-31 and 33-42_ is/are rejected.

7) ☒ Claim(s) _8 and 32_ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☒ Interview Summary (PTO-413) Paper No(s). _14_ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 2/7/2002, preliminary amendment filed

3/30/2002, to the original application filed 1/5/2001, with provisional filing date of **1/31/2000**. IDS

filed 4/23/2001 and 4/25/2001.

2.   Examiner acknowledges petition to make special under MPEP 708.02 VIII, filed 4/25/2001,

said petition granted 6/8/2001.

3.   The rejection of claims 1-42 under 35 U.S.C. 103(a) as being unpatentable over Borgendale and

Fuji-Xerox has been withdrawn as necessitated by amendment.

4.   Claims 1-42 are pending. Claims 1, 15, 25, 39 are independent claims.

Continued Examination Under 37 CFR 1.114

5.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR

1.17(e), was filed in this application after final rejection. Since this application is eligible for continued

examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the

finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's

submission filed on 2/7/2002 and 3/30/2002 has been entered.

Allowable Subject Matter

6.   Claims 8, 32 are objected to as being dependent upon a rejected base claim, but would be

allowable if rewritten in independent form including all of the limitations of the base claim and any

intervening claims.

Claim Rejections - 35 USC § 103

7.   **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness**

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of
> this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as
> a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 1-7, 9-31, 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Borgendale et al. (hereinafter Borgendale), U.S. Patent No. 5,276,793 issued January 1994, in view

of Fuji Xerox (hereinafter Fuji Xerox), Japanese Application - Pub. No. JP 08030619 A, with

publication date of February 2, 1996, and further in view of Fallside, U.S. Patent No. 6,003,048

issued December 1999.

        In regard to independent claim 1, Borgendale teaches:

        - an editor for producing/modifying structured documents (Borgendale Abstract; compare with

claim 1 *"a method of producing structured documents, the method comprising:"*).

        - receiving a document within a document construction module with DTDs, which can reside on

a diskette (Borgendale column 8 lines 39-46; compare with claim 1 *"receiving a definition file including*

document type definitions (DTD)").

        - a file including a number of objects indicative of "decorative" attributes, such as font, etc.

(Borgendale Figures 19-21 - middle section in each figure; compare with claim 1 *"...including a number*

of displayable objects", and *" respective decoration attributes about each of the displayable objects"*).

        - a document type definition with a file indicating a base style for a document (a metafile)

(Borgendale column 13 lines 18-30). Borgendale does not specifically teach display of said base style

with a DTD and objects. However, Fuji Xerox teaches a document editing device which performs

structure editing of a document displayed as a table, based on a DTD (Fuji Xerox Abstract, also Figures

4-11; compare with claim 1 *"displayable objects being displayed"*). It would have been obvious to one of

ordinary skill in the art at the time of the invention to apply Fuji Xerox to Borgendale, because of Fuji

Xerox's taught advantage of graphical displays regarding structured files, providing a user of Borgendale

a way to create better documents by visualizing its structural mapping.

- a document type definition with a file indicating a base style for a document (a metafile) said

files revealing an association of elements and objects (Borgendale column 13 lines 18-30, Figures 19-21;

compare with claim 1 *"associating at least one of the definitions in the definition file with one of the*

displayable objects").

- creation of a structured document subsequent to a user's document editing and interaction with a

document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 1

"creating the structured document....with one of the displayable objects").

- Borgendale does not specifically teach creating a structured document from an initial output

presentation. However, Fallside teaches conversion of a coordinate based document (image based) to an

equivalent tag based structured document (a markup language document) (Fallside Abstract, Figure 5A,

column 3 lines 50-67 to column 4 lines 1-23; compare with claim 1 *"output presentation"*, and *"creating*

the structured document from the output presentation"). It would have been obvious to one of ordinary

skill in the art at the time of the invention to apply Fallside to Borgendale, providing Borgendale the

capability of creating structured documents from initial inputted image files, increasing Borgendale's

versatility by converting an array of differing presentations.

In regard to dependent claim 2, Borgendale teaches style information in the form of an

"MLOOK" set, which is indicative of a metafile associated with modified elements, as well as associated

with a DTD (Borgendale column 6 lines 66-68, column 7 lines 60-65; compare with claim 2).

In regard to dependent claim 3, Borgendale teaches converting a document with metafile to

SGML utilizing a defined element look table, and a Structure table (Borgendale column 6 lines 22-32,

Figures 5, 11, 12; compare with claim 3).

In regard to dependent claim 4, Borgendale teaches a document type definition, which

describes a structure for document elements corresponding to displayable objects in a metafile

(Borgendale column 6 lines 34-37; compare with claim 4).

In regard to dependent claim 5, Borgendale teaches document elements in a hierarchical

presentation, each corresponding to objects in a metafile (Borgendale Figure 11; compare with claim 5).

In regard to dependent claim 6, Borgendale teaches document identifiers associated with

elements and pointers (Borgendale Figures 11, 12; compare with claim 6).

In regard to dependent claim 7, Borgendale teaches identifiers as alphanumeric text, as well as

font, color, style (Borgendale column 6 lines 23; Figure 12 item Element Tag; compare with claims 7-8).

In regard to dependent claims 9-11, Borgendale teaches a construction module used for the

creation/modification of documents associated with DTDs utilizing defined/modified looks, user

modification of said document with respect to alphanumeric text, color, font, size, and style results in

changes in identifiers (Borgendale column 6 lines 23, column 13 lines 18-40; compare with claims 9-11).

In regard to dependent claims 12-14, Borgendale teaches an editor whereby a user can generate

documents associated with a DTD, said document can be initially generated as a text document, and

resulting "look" of said document reflects characters, font, size, etc. (Borgendale Abstract, near top, also Figures 11-12; compare with claims 12-14).

In regard to independent claim 15, Borgendale teaches:

- an editor for producing/modifying structured documents (Borgendale Abstract; compare with claim 15 "*a method of producing structured documents, the method comprising:*").

- receiving a document within a document construction module with DTDs, which can reside on a diskette (Borgendale column 8 lines 39-46; compare with claim 15 "*a definition file including...document type definitions includes an identifier*").

- a file including a number of objects indicative of "decorative" attributes, such as font, etc. (Borgendale Figures 11-12, 19-21 - middle section in each figure; compare with claim 15 "*...wherein the metafile including a number of displayable objects*", and "*and respective decoration attributes about each of the displayable objects, and wherein each of the document type definitions includes an identifier*").

- a document type definition with a file indicating a base style for a document (a metafile) (Borgendale column 13 lines 18-30). Borgendale does not specifically teach display of said metafile with a DTD and objects. However, Fuji Xerox teaches a document editing device which performs structure editing of a document displayed as a table, based on a DTD (Fuji Xerox Abstract, also Figures 4-11; compare with claim 15 "*activating an environment including a first display and a second display...including document type definitions (DTD)*", and "*displayable objects being displayed*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fuji Xerox to Borgendale, because of Fuji Xerox's taught advantage of graphical displays regarding structured files, providing a user of Borgendale a way to produce better documents by visualizing its structural mapping.

- Borgendale teaches a document construction module comprising groups of DTDs and

corresponding sets of base-styles (Borgendale column 8 lines 40-46; compare with claim 15 *"grouping a*

number of group objects, each of the group objects including a number of the displayable objects").

- a document type definition with a file indicating a base style for a document (a metafile) said

files revealing an association of elements and objects (Borgendale column 13 lines 18-30, Figures 19-21;

compare with claim 15 *"associating each of the group...in one of the document type definitions"*).

- creation of a structured document subsequent to a user's document editing and interaction with a

document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 15

"creating the structured document ....with one of the displayable objects").

- Borgendale does not specifically teach creating a structured document from an initial output

presentation. However, Fallside teaches conversion of a coordinate based document (image based) to an

equivalent tag based structured document (a markup language document) (Fallside Abstract, Figure 5A,

column 3 lines 50-67 to column 4 lines 1-23; compare with claim 15 *"output presentation"*, and *"creating*

the structured document from the output presentation"). It would have been obvious to one of ordinary

skill in the art at the time of the invention to apply Fallside to Borgendale, providing Borgendale the

capability of creating structured documents from initial inputted image files, increasing Borgendale's

versatility by converting an array of differing presentations.

In regard to dependent claim 16, Borgendale teaches style information in the form of an

"MLOOK" set, which is indicative of a metafile associated with modified elements, as well as associated

with a DTD (Borgendale column 6 lines 66-68, column 7 lines 60-65; compare with claim 16).

In regard to dependent claim 17, Borgendale teaches converting a document with metafile to

SGML utilizing a defined element look table, and a Structure table (Borgendale column 6 lines 22-32,

Figures 5, 11, 12; compare with claim 17).

In regard to dependent claim 18, Borgendale teaches a markup language (SGML) which is generally suitable for display on applications made to interpret said language (Borgendale column 6 lines 25-33; compare with claim 18).

In regard to dependent claims 19-20, Borgendale teaches SGML (Borgendale column 6 lines 25-33). Borgendale does not specifically teach the Internet. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, because SGML and hypertext suggests an Internet embodiment, providing the advantage of a familiar communication medium to Borgendale.

In regard to dependent claims 21-22, Borgendale teaches an editor whereby a user can generate documents associated with a DTD, said document can be generated as a text document, and resulting "look" of said document reflects characters, font, size, etc., as well as resulting character objects (Borgendale Abstract, near top, also Figures 11-12; compare with claims 21-22).

In regard to dependent claim 23, Borgendale teaches identifiers as alphanumeric text, as well as font, color, style (Borgendale column 6 lines 23; Figure 12 item Element Tag; compare with claim 23).

In regard to dependent claim 24, Borgendale teaches a construction module used for the creation/modification of documents associated with DTDs utilizing defined/modified looks, user modification of said document with respect to alphanumeric text, color, font, size, and style results in changes in identifiers (Borgendale column 6 lines 23, column 13 lines 18-40; compare with claim 24).

In regard to independent claim 25, Borgendale teaches:

- an editor for producing/modifying structured documents (Borgendale Abstract; compare with claim 25 "*a machine readable medium...the machine readable medium comprising:*").

- receiving a document within a document construction module with DTDs, which can reside on a diskette (Borgendale column 8 lines 39-46; compare with claim 25 "program code for *receiving a definition file including document type definitions (DTD)*").

- a file including a number of objects indicative of "decorative" attributes, such as font, etc. (Borgendale Figures 19-21 - middle section in each figure; compare with claim 25 "*...the metafile including a number of displayable objects*", and "*and respective decoration attributes about each of the displayable objects*").

- a document type definition with a file indicating a base style for a document (a metafile) (Borgendale column 13 lines 18-30). Borgendale does not specifically teach display of said metafile with a DTD and objects. However, Fuji Xerox teaches a document editing device which performs structure editing of a document displayed as a table, based on a DTD (Fuji Xerox Abstract, also Figures 4-11; compare with claim 25 "*program code for displaying a metafile along with the definition file...*", and "*displayable objects being displayed*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fuji Xerox to Borgendale, because of Fuji Xerox's taught advantage of graphical displays regarding structured files, providing a user of Borgendale a way to visualize structural mapping.

- a document type definition with a file indicating a base style for a document (a metafile) said files revealing an association of elements and objects (Borgendale column 13 lines 18-30, Figures 19-21; compare with claim 25 "*program code for associating at least one of the definitions in the definition file with one of the displayable objects*").

- creation of a structured document subsequent to a user's document editing and interaction with a

document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 25

"program code for creating the structured document ....with one of the displayable objects").

- Borgendale does not specifically teach creating a structured document from an initial output

presentation. However, Fallside teaches conversion of a coordinate based document (image based) to an

equivalent tag based structured document (a markup language document) (Fallside Abstract, Figure 5A,

column 3 lines 50-67 to column 4 lines 1-23; compare with claim 25 *"output presentation"*, and *"creating*

the structured document from the output presentation"). It would have been obvious to one of ordinary

skill in the art at the time of the invention to apply Fallside to Borgendale, providing Borgendale the

capability of creating structured documents from initial inputted image files, increasing Borgendale's

versatility by converting an array of differing presentations.

In regard to dependent claims 26-31, 33-38, claims 26-31, 33-38 reflect the machine readable

medium comprising computer readable instructions for performing the methods as claimed in claims 2-7,

9-14 respectively, and are rejected along the same rationale.

In regard to independent claim 39, Borgendale teaches:

- an editor for producing/modifying structured documents (Borgendale Abstract; compare with

claim 39 *"a machine readable medium... the machine readable medium comprising:"*).

- receiving a document within a document construction module with DTDs, which can reside on

a diskette (Borgendale column 8 lines 39-46; compare with claim 39 *"a definition file*

including...document type definitions includes an identifier").

- a file including a number of objects indicative of "decorative" attributes, such as font, etc.

(Borgendale Figures 11-12, 19-21 - middle section in each figure; compare with claim 39 *"...wherein the*

metafile including a number of displayable objects ", and *"and respective decoration attributes about*

each of the displayable objects, and wherein each of the document type definitions includes an

identifier").

      - a document type definition with a file indicating a base style for a document (a metafile)

(Borgendale column 13 lines 18-30). Borgendale does not specifically teach display of said metafile with

a DTD and objects. However, Fuji Xerox teaches a document editing device which performs structure

editing of a document displayed as a table, based on a DTD (Fuji Xerox Abstract, also Figures 4-11;

compare with claim 39 *"program code for activating an environment including a first display and a*

second display...including document type definitions (DTD) ", and *"displayable objects being*

displayed"). It would have been obvious to one of ordinary skill in the art at the time of the invention to

apply Fuji Xerox to Borgendale, because of Fuji Xerox's taught advantage of graphical displays

regarding structured files, providing a user of Borgendale a way to visualize structural mapping.

      - Borgendale teaches a document construction module comprising groups of DTDs and

corresponding sets of base-styles (Borgendale column 8 lines 40-46; compare with claim 39 *"program*

code for forming a number of group objects, each of the group objects including one or more of the

displayable objects").

      - a document type definition with a file indicating a base style for a document (a metafile) said

files revealing an association of elements and objects (Borgendale column 13 lines 18-30, Figures 19-21;

compare with claim 39 *"program code for associating each of the group...in one of the document type*

definitions").

      - creation of a structured document subsequent to a user's document editing and interaction with a

document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 39

"program code for creating the structured document ....with one of the displayable objects").

      - Borgendale does not specifically teach creating a structured document from an initial output

presentation. However, Fallside teaches conversion of a coordinate based document (image based) to an

equivalent tag based structured document (a markup language document) (Fallside Abstract, Figure 5A,

column 3 lines 50-67 to column 4 lines 1-23; compare with claim 39 *"output presentation"*, and *"creating the structured document from the output presentation"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fallside to Borgendale, providing Borgendale the capability of creating structured documents from initial inputted image files, increasing Borgendale's versatility by converting an array of differing presentations.

In regard to dependent claims 40, 41, 42, claims 40, 41, 42 reflect the machine readable medium comprising computer readable instructions for performing the methods as claimed in claims 16, 17, 21 respectively, and are rejected along the same rationale.

Response to Arguments

9.   No argument is presented by Applicant . Accordingly, no response is deemed necessary by the Examiner at the present time.

Conclusion

10.   **Prior art made of record and not relied upon is considered pertinent to disclosure.**

Fong et al.   U.S. Patent No. 6,279,015   issued   08/2001

Shankar, Gess, XMetal speeds content creation, InfoWorld, August 16, 1999, Vol.21, Issue 33, pp.1-4.

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on **(703) 308-5186**.

Any inquiry of a general nature or relating to the status of this application should be directed to

the Group receptionist whose telephone number is **(703) 305-3900.**

12.   **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:
(703) 746-7239 (for formal communications intended for entry)
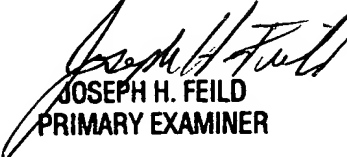
or:
(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

or:
(703) 746-7238 (for after-final communications)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).**

William L. Bashore
05/01/2002

JOSEPH H. FEILD
PRIMARY EXAMINER